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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,887	02/02/2004	Michael J. Curtis	119-P-05	7932

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EXAMINER

STEWART, ALVIN J

ART UNIT PAPER NUMBER

3738

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/768,887	Applicant(s) CURTIS, MICHAEL J.	
	Examiner Alvin J. Stewart	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 29-33 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 29-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/19/5; 1/24/5</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "a first prosthetic component" in line 4. There is insufficient antecedent basis for this limitation in the claim. The Applicant's representative discloses the first prosthetic component previously in the preamble of the claim.

Claim 1 recites the limitation "a second prosthetic component" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the distance" in line 11. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the first selected position" in lines 2 & 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the second selected position" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 4, claim 4 has the same problems as claim 1. Correction is required.

The above criticisms are not exhaustive. Applicant should carefully revise the claims.

Claim Objections

Claim 1 is objected to because of the following informalities: in line 7, the word "holt" is misspelled. Line 12 should said ---said second end---, instead of "said second". Appropriate correction is required.

Claim 2 is objected to because of the following informalities: the "third selected position" and the "fourth selected position" are objected because the Applicant's representative has not disclosed a first and second selected positions. Appropriate correction is required.

The above criticisms are not exhaustive. Applicant should carefully revise the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12, 14-17 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Garcia US Patent 3,400,408.

Garcia discloses a prosthesis comprising a first end (45), a first prosthetic component (60), a second end (44), a second prosthetic component (30) and a main body (40) between the first end and the second end.

Regarding the distance between the first component and the second component, Figure 3 clearly discloses the wherein clause. The distance is partially the selected length of the main body.

Art Unit: 3738

Regarding claim 10, the examiner has interpreted the claims as following: socket (92), a first prosthetic component (90), a sleeve module (60), a spacer module (46), a second prosthetic component (20) and a foot (5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 18 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia US Patent 3,400,408.

Garcia discloses the invention substantially as claimed. However, Garcia does not disclose a second spacer module having a second length and at least one al threaded end.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the spacer module of the Garcia reference by adding a second spacer module in order to increase the length of the prosthesis or adding external threads because Applicant has not disclosed that by adding a second spaced module with external threads provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the spaced module of the Garcia reference because it would perform equally as well.

Therefore, it would have been an obvious matter of design choice to modify the Garcia reference to obtain the invention as specified in claims 13, 18 and 31-33.

Art Unit: 3738

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. Stewart
ALVIN J. STEWART
PRIMARY EXAMINER
Art Unit 3738

January 12, 2005.